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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,491	08/22/2003	Toru Macda	00862.002709.1	8745
5514	7590	08/09/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			POKRZYWA, JOSEPH R	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/645,491	Applicant(s) MAEDA, TORU	
	Examiner Joseph R. Pokrzywa	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 71-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 71, 72, 75 and 76 is/are rejected.
- 7) ☒ Claim(s) 73, 74, 77 and 78 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/258,196.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/14/03 & 8/22/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Preliminary Amendment

1. Applicant's preliminary amendment was received on 8/22/03, and has been entered and made of record. Currently, **claims 71-78** are pending.

Information Disclosure Statement

2. The references listed in the Information Disclosure Statement submitted on 10/14/03 and 8/22/03 have been considered by the examiner (see attached PTO-1449's).

Drawings

3. The drawings received on 8/22/03 are acceptable to the examiner.

Claim Objections

4. **Claims 71, 75, and 76** are objected to because of the following informalities:

In **claim 71**, line 1, "suing" should read "using";

in **claim 75**, line 10, "suing" should read "using"; and

in **claim 76**, line 3, "lis" should read "is".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claim 71** is rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki (U.S. Patent Number 6,005,677, cited in the Information Disclosure Statement dated 10/14/03).

Regarding **claim 71**, Suzuki discloses an Internet address informing method *using* an Internet facsimile apparatus for transmitting and receiving an image by an Internet facsimile transmitting/receiving function and an ordinary facsimile transmitting/receiving function (see Figs. 1 and 4), characterized in that an Internet facsimile apparatus on a transmitting side transmits an Internet facsimile function (LAN transmitting processing, step 108 in Fig. 4, column 4, lines 26-45), and Internet address thereof on first and second signals in a standard protocol of ordinary facsimile communication (column 3, line 66-column 5, line 14), and an Internet facsimile apparatus on a receiving side detects and registers the Internet facsimile function (steps 105, 114, and 115 in Fig. 4, column 4, line 31-column 5, line 20), and Internet address of said Internet facsimile apparatus on the transmitting side, carried on the first and second signals in the standard protocol of ordinary facsimile communication, as destination data (see Fig. 4), and when transmission is to be performed for said Internet facsimile apparatus on the transmitting side thereafter, communicates with said Internet facsimile apparatus on the transmitting side by using the Internet address in the destination data (column 5, lines 4-20).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 72, 75, and 76** are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. Patent Number 6,005,677, cited in the Information Disclosure Statement dated 8/22/03) in view of Sato (U.S. Patent Number 6,230,189, cited in the Information Disclosure Statement dated 10/14/03).

Regarding *claim 72*, Suzuki discloses the method discussed above in claim 71, and further teaches of being characterized in that the ordinary facsimile communication is G3 facsimile communication (column 3, lines 11-65).

However, Suzuki fails to expressly disclose if the first signal is a TSI signal and carries the telephone number of said Internet facsimile apparatus on the transmitting side, and the second signal is an NSS signal and carries the Internet facsimile function and Internet address of said Internet facsimile apparatus on the transmitting side.

Sato discloses an Internet address informing method *using* an Internet facsimile apparatus for transmitting and receiving an image by an Internet facsimile transmitting/receiving function and an ordinary facsimile transmitting/receiving function (see Figs. 1-3B), characterized in that an Internet facsimile apparatus on a transmitting side transmits an Internet facsimile function (column 3, line 54-column 7, line 53), and Internet address thereof on first and second signals in a standard protocol of ordinary facsimile communication (column 3, line 54-column 7, line 53).

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Further, Sato discloses that the first signal is a TSI signal and carries the telephone number of said Internet facsimile apparatus on the transmitting side, and the second signal is an NSS signal and carries the Internet facsimile function and Internet address of said Internet facsimile apparatus on the transmitting side (see Figs. 3A-3B, column 7, lines 33-53).

Suzuki & Sato are combinable because they are from the same field of endeavor, being facsimile systems that transmit data via the Internet. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have Suzuki's system have the first signal be a TSI and the second signal be a NSS signal of standard protocol of ordinary facsimile communication, as taught by Sato in Figs. 3A and 3B. The suggestion/motivation for doing so would have been that Suzuki's system would adhere to industry standards in facsimile communication protocol, as recognized by Sato in Figs. 3A and 3B, and in column 7, line 32-column 8, line 10. Therefore, it would have been obvious to combine the teachings of Sato with the system of Suzuki to obtain the invention as specified in claim 72.

Regarding *claim 75*, Suzuki discloses the method discussed above in claim 71, and further teaches of being characterized in that the Internet facsimile apparatus on the transmitting side detects and registers the Internet facsimile function and Internet address of said Internet facsimile apparatus on the receiving side, carried on *a signal* in the standard protocol of ordinary facsimile communication, as destination data, and when transmission is to be performed for said Internet facsimile apparatus on the receiving side thereafter, communicates with said Internet facsimile apparatus on the receiving side by *using* the Internet address in the destination data (steps 105, 114, and 115 in Fig. 4, column 4, line 31-column 5, line 20).

However, Suzuki fails to expressly disclose if said Internet facsimile apparatus on the receiving side transmits the Internet facsimile function and Internet address thereof on a third signal in the standard protocol of ordinary facsimile communication.

Sato discloses an Internet address informing method *using* an Internet facsimile apparatus for transmitting and receiving an image by an Internet facsimile transmitting/receiving function and an ordinary facsimile transmitting/receiving function (see Figs. 1-3B), characterized in that an Internet facsimile apparatus on a transmitting side transmits an Internet facsimile function (column 3, line 54-column 7, line 53), and Internet address thereof on first and second signals in a standard protocol of ordinary facsimile communication (column 3, line 54-column 7, line 53). Further, Sato discloses that the Internet facsimile apparatus on the receiving side transmits the Internet facsimile function and Internet address thereof on a third signal in the standard protocol of ordinary facsimile communication (see Figs. 3A-3B, column 7, lines 33-53).

Suzuki & Sato are combinable because they are from the same field of endeavor, being facsimile systems that transmit data via the Internet. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have the Internet address in the NSF signal, as taught by Suzuki, in the third signal of standard protocol of ordinary facsimile communication, as taught by Sato in Figs. 3A and 3B. The suggestion/motivation for doing so would have been that Suzuki's system would adhere to industry standards in facsimile communication protocol, as recognized by Sato in Figs. 3A and 3B, and in column 7, line 32-column 8, line 10. Therefore, it would have been obvious to combine the teachings of Sato with the system of Suzuki to obtain the invention as specified in claim 75.

Regarding **claim 76**, Suzuki and Sato disclose the method discussed above in claim 75, and Suzuki further teaches of being characterized in that the standard facsimile communication is G3 facsimile communication (column 3, lines 36-42), and the third signal is an NSF signal (column 4, line 57-column 5, line 59) and carries the Internet facsimile function and Internet address of said Internet facsimile apparatus on the receiving side (column 4, line 57-column 5, line 59).

Allowable Subject Matter

9. **Claims 73, 74, 77 and 78** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding **claims 73 and 77**, in the examiner's opinion, it would not have been obvious to have the method, as claimed, include the feature of having the Internet facsimile function stored in a fourth octet of the NSS or NSF signal and transmitted, and the Internet address being stored in fifth to twenty-fifth octets of the NSS or NSF signal and transmitted.

Citation of Pertinent Prior Art

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Mori (U.S. Patent Number 6,417,930) discloses a facsimile apparatus capable of relaying e-mail; and

Joffe (U.S. Patent Number 6,559,980) discloses a method of increasing speed of non-error corrected fax transmissions that utilizes different octets in the transmission signal.

Conclusion

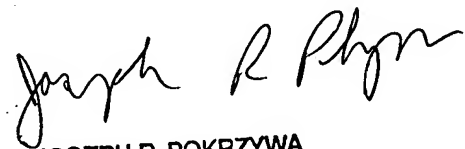
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joseph R. Pokrzywa
Primary Examiner
Art Unit 2625

jrp


JOSEPH R. POKRZYWA
PRIMARY EXAMINER